REMARKS/ARGUMENTS

1. Claims 1 - 54 are pending in this application. The Examiner has allowed claims 14 - 19, and further has allowed claim 12 if rewritten in independent form. Applicant thanks the Examiner for these allowances.

2. With regard to the claims, claims 5, 22, 31 and 46 were amended. No new claims were added. Consideration of claims 1 - 54 is requested.

I. FULLER AND JACKMAUH REFERENCES

3. The Examiner rejected claims **1, 3, 4, 6, 8, 9, 13, 20, 21, 24, 26, 27, 29, 30, 33, 36, 38 - 40, 42, 44, 48, 50, 51, 52,** and **54** under 35 U.S.C. 103 as being unpatentable over Fuller (U.S. Patent No. 4,967,867) in view of Jackmauh (U.S. Patent No. 5,546,665). Applicant respectfully submits that none of the rejected claims is unpatentable over Fuller in view of Jackmauh.

A. Fuller Should Not Be Combined With Jackmauh

4. As an initial matter, Applicant submits that this rejection is not sustainable on the grounds that a *prima facie* case of obviousness has not been made. As pointed out in the MPEP, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If a *prima facie* case is not produced, an applicant is under no obligation to submit evidence of nonobviousness. MPEP §2142.

5. To establish a *prima facie* case of obviousness, among other things there must be some suggestion or motivation to combine reference teachings. MPEP §2143. Either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. MPEP 706.02(j).

6. In this matter, the Examiner stated that Fuller fails to show the frame having inner and outer wall portions with openings in each wall, but that Jackmauh shows an axle

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positioner mounted within a frame. Then the Examiner concluded that it would have been obvious to position the axle adjuster of Fuller within a frame section as taught by Jackmauh, in order to position the adjuster compactly.

7. Applicant submits that this does not constitute an adequate showing of the motivation to combine Fuller with Jackmauh. According to the MPEP, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01.III. Here the Examiner has not cited to any portion of Fuller or Jackmauh where there is a suggestion as to the desirability of combining these references or of the desirability of positioning the adjuster of Fuller compactly within a frame. Neither of these references point to "compact positioning" as a relevant problem in need of a solution, nor does this constitute a convincing line of reasoning as to why an artisan would have combined these references. Fuller should not be combined with Jackmauh because "compact positioning" is not a valid motivation for this combination. Therefore the rejection to the foregoing claims should be withdrawn on these grounds.

8. There is another, independent basis for not combining Fuller with Jackmauh. A review of Fuller shows that it teaches away from its combination with Jackmauh. The Fuller invention relates to "a cover assembly for achieving the 'custom look' at the protruding ends of the rear axle of a HARLEY-DAVIDSON™ motorcycle and for obviating the possibility that a person's clothes or anything else might get caught on either of these protruding ends of the axle." A principal object of Fuller is to "provide a novel cover assembly for covering the protruding parts at either end of the rear axle of a HARLEY-DAVISON™ motorcycle." Another object is to "provide such a cover assembly which is readily attachable to the rear axle/frame horn of the motorcycle and requires no modification of the axle assembly of the motorcycle." (Col. 1, lines 8 - 32) (*emphasis added*).

9. Thus it is a goal of Fuller to maintain the HARLEY-DAVIDSON™ custom look. This custom HARLEY-DAVIDSON™ look includes having protruding ends of the rear axle. Thus, the cover assembly of Fuller must require no modification of the axle assembly. Accordingly, Fuller teaches away from its combination with Jackmauh. To modify Fuller as suggested by the Examiner would require somehow placing the thrust collar 17 of Fuller into the frame section of Jackmauh. As best seen in FIG. 6 of Fuller, the thrust collar 17 abuts an

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outwardly extending portion of the axle frame horn 13 portion of the motorcycle frame. Thus the thrust collar 17 is one of the "protruding parts" for which it is a principal object of Fuller to cover with a removable cover assembly. Moreover, to place the thrust collar 17 of Fuller into the Jackmauh frame section would require modification of the axle assembly - contrary to one of the principal objects of the Fuller invention.

10. Because it is improper to combine references where they teach away from their combination (MPEP §2145.X.D.2), Fuller and Jackmauh do not render the rejected claims unpatentable. Withdrawal of the rejection to claims 1, 3, 4, 6, 8, 9, 13, 20, 21, 24, 26, 27, 29, 30, 33, 36, 38 - 40, 42, 44, 48, 50, 51, 52, and 54 is requested.

B. Independent Claims 1, 20 and 29 and the Actuator/Frame Bore Limitations

11. In addition to the reasons given in paragraphs 4 to 10 above, there are further grounds for withdrawing the rejections to claims 1, 20 and 29. In the office action, the Examiner has taken the position that Fuller discloses all limitations of independent claims **1, 20 and 29** except for a frame having inner and outer wall portions with openings in each wall. Applicant respectfully disagrees. These claims each require that the openings in the inner and outer wall portions extend into a frame cavity. Moreover, there must be an actuator adapted for insertion into a frame bore that extends from the frame cavity. The Examiner has cited no portion of Fuller that discloses an actuator adapted for insertion into a frame bore that extends from a frame cavity.

12. The axle adjustor bolt 24 of Fuller passes through an opening 16 in the axle horn wall 15. However this opening 16 does not extend from any frame cavity. When attached to the axle horn 13, the cover 31 of Fuller encloses both the axle adjustor bolt 24 and the opening 16. (*see* Col. 3, lines 53 - 56; and FIGs. 3 and 5, reference numeral 44) In the office action, the Examiner has not made clear whether or what the Examiner considers to be a frame cavity in Fuller. While the Examiner states at page 2 that the cover "completes the enclosure of the adjustment apparatus," it has not been made clear whether the Examiner considers this "enclosure" to be a frame cavity within the meaning of the rejected patent claims. According to the MPEP, it is important for the basis for a rejection be properly communicated so that the issues can be identified early and the applicant can be given fair

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opportunity to reply. MPEP 706.02(j). In this respect, therefore, a *prima facie* case of obviousness has not been made.

13. Even assuming for sake of argument, however, that the Examiner considers the cover 31 to form a frame cavity when attached to the axle horn, the opening 16 in the axle horn wall is completely enclosed by the cover 31. Therefore even under this assumption, the opening 16 of Fuller cannot be considered to extend from the frame cavity.

14. Because the Examiner has cited no portion of Fuller that discloses this limitation, the rejections to claims 1, 20 and 29 should be withdrawn. Moreover, claims 3, 4, 6, 8, 9, 13, 21, 24, 26, 27, 30, 33, 36 are dependent claims that depend directly or indirectly from one of the independent claims 1, 20 or 29, and contain additional limitations. The rejections to each of these dependent claims therefore should be withdrawn for the same reasons.

C. Method Claims 38 - 40, 42, 44, 48 and 50 are not Rendered Obvious by Fuller in View of Jackmauh

15. In addition to the reasons given in paragraphs 4 to 10 above, there are further grounds for withdrawing the rejection to method claims **38 - 40, 42, 44, 48** and **50**. Independent method claim 38 includes the limitation of inserting an axle coupler into a frame cavity. The Examiner has cited no portion of either Fuller or Jackmauh that discloses this limitation.

16. As seen in FIG. 6 of Fuller, the clamping nut 18 and washer 19 are disposed on the outside of the thrust collar 17 which in turn abuts the outer surface of an outwardly protruding portion of the axle frame horn 13. Indeed, the clamping nut 18 is a "protruding part" for which the cover assembly of Fuller is provided as a "principal object" of the Fuller invention. (Col. 1, lines 25 - 28) The cited portions of Fuller disclose no step of inserting an axle coupler into a frame cavity.

17. Referring next to FIG. 6 of Jackmauh, there is shown an axle nut 34 that engages an axle 32. The axle nut 34 and perhaps a washer abut the outer surface of a swing arm 30. The cited portions of Jackmauh however do not disclose the insertion of any axle coupler into a frame cavity.

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18. Because the cited portions of neither Fuller nor Jackmauh disclose this limitation, the rejection to independent method claim 38 should be withdrawn. Moreover, claims 39, 40, 42, 44, 48 and 50 are dependent claims that depend directly or indirectly from claim 38, and contain additional limitations. The rejections to each of these dependent method claims therefore should be withdrawn for the same reasons.

D. Claims 51, 52 and 54 are not Rendered Obvious by Fuller in view of Jackmauh

19. In addition to the reasons given in paragraphs 4 to 10 above, there are further grounds for withdrawing the rejection to claims 51, 52 and 54. Independent claim 51 requires that there be a coupling means that is adapted for insertion through a vehicle frame distal opening. The Examiner has cited no portion of either Fuller or Jackmauh that discloses this limitation.

20. As to Fuller, the Examiner stated that this reference "fails to show the frame having inner and outer wall portions with openings in each wall." (Page 2, Office Action) Thus the Examiner has cited no portion of Fuller that discloses a distal opening for inserting an axle coupling means.

21. Referring again to FIG. 6 of Jackmauh, there is shown an axle nut 34 that engages an axle 32. The axle nut 34 and perhaps a washer abut the outer surface of a swing arm 30. The cited portions of Jackmauh however do not disclose the insertion of any axle coupling means through a frame distal opening.

22. Because the cited portions of neither Fuller nor Jackmauh disclose this limitation, the rejection to independent claim 51 should be withdrawn. Moreover, claims 52 and 54 are dependent claims that depend directly or indirectly from claim 51, and contain additional limitations. The rejections to each of these dependent claims therefore should be withdrawn for the same reasons.

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E. Additional Reasons Certain Dependent Claims are not Rendered Obvious by Fuller in view of Jackmauh

23. Paragraphs 4 to 22 above have set forth several independent reasons why all of the claims that were rejected on the basis of Fuller in view of Jackmauh should not have been rejected on those grounds. As to certain dependent claims, however, there are yet further independent reasons why the rejections to these claims should be withdrawn.

24. (Claims **4, 21, 30** and **44**): Claims **4, 21** and **30** each require that the axle coupler be adapted for insertion into the frame cavity through the frame distal opening. Similarly, claim **44** requires inserting the axle coupler into the frame cavity through the frame distal opening. For the reasons given in paragraphs 19 to 22 above, the cited portions of neither Fuller nor Jackmauh disclose this limitation. Accordingly the rejection to claims 4, 21, 30 and 44 should be withdrawn.

25. Claims **5, 22** and **31** have been amended so that each requires the axle coupler to have a generally cylindrically-shaped body portion and a threaded extension portion extending from the body portion. These claims further require that the adjustor member bearing surface define an opening adapted to mate with the generally cylindrically-shaped body portion of axle coupler. Applicant contends that none of the cited portions of Fuller or Jackmauh disclose this opening limitation.

26. The thrust collar 17 of Fuller has an opening. However, this opening is for the axle 14 to pass through. Similarly, the stud 16 of Jackmauh includes a ring 12. However this ring 12 also is for the axle 32 to pass through. The Examiner has cited no portions of either Fuller or Jackmauh that disclose the adjuster member opening limitation of claims 5, 22 and 31. The rejection to claims 5, 22 and 31 therefore should be withdrawn.

27. Claims **6, 24, 33, 42** and **52** require the frame bore to extend longitudinally from the frame cavity through the frame in a direction generally away from the first axle and the second axle. In paragraphs 11 to 14 above, Applicant has shown the deficiencies in the rejections to dependent claims 6, 24 and 33 with respect to a frame bore that extends from a frame cavity. Those reasons are incorporated herein as grounds for withdrawal of the rejection to claims 42 and 52, as well as to claims 6, 24 and 33.

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28. Additionally, however, claims 6, 24, 33, 42 and 52 each further require that the bore extend from the cavity through the frame in a direction generally away from the first and the second axle. In the office action, the Examiner has taken the position that Fuller discloses all limitations of claims 6, 24, 33, 42 and 52 except for a frame having inner and outer wall portions with openings in each wall. Applicant respectfully disagrees. Applicant contends that the Examiner has cited no portion of Fuller that discloses this additional limitation pertaining to the direction of bore extension.

29. Fuller discloses an opening 16 in an axle horn wall 15. However, the Examiner has cited no portion of Fuller that discloses how this could be considered to extend in a direction generally away from the first and second axle. The rejections to claims 6, 24, 33, 42 and 52 therefore should be withdrawn.

30. Claims 8 and 26 require the axle coupler to have a proximate end adapted to engage the first axle and a distal end, wherein the distal end is disposed within the frame cavity. As explained in paragraphs 11 to 14, a *prima facie* case has not been made with respect to the frame cavity limitation. Applicant repeats those arguments here, and further notes that the clamping nut 18 of Fuller is a "protruding part" for which the cover assembly of Fuller is provided as a "principal object" of the Fuller invention. (Col. 1, lines 25 - 28) If the Examiner does not consider the area enclosed by the cover 31 to be a frame cavity within the meaning of the rejected claims, then there still has been no *prima facie* showing of how Fuller discloses this limitation.

31. Similarly, there has been no cited portion of Jackmauh that discloses an axle coupler distal end disposed within a frame cavity. Jackmauh shows an axle nut 34 that is mounted entirely outside of the swing arm 30. There is no explanation, however, whether or how Jackmauh discloses this claim limitation. The rejection to claims 8 and 26 therefore should be withdrawn.

32. Claims 9, 27, 36, 48 and 54 include the limitation that no portion of the axle coupler (or of the coupling means, as the case may be) extend outside of the frame cavity through the frame distal opening. As to Fuller, the Examiner stated that this reference "fails to show the frame having inner and outer wall portions with openings in each wall." (Page 2, Office Action) Thus the Examiner has cited no portion of Fuller that discloses a distal opening.

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33. Referring again to FIG. 6 of Jackmauh, there is shown an axle nut 34 that engages an axle 32. The axle nut 34 and perhaps a washer abut the outer surface of a swing arm 30. The cited portions of Jackmauh however do not disclose this limitation. Therefore because the cited portions of neither Fuller nor Jackmauh disclose this limitation, the rejection to claims 9, 27, 36, 48 and 54 should be withdrawn.

34. With respect to claim **43**, this claim is indicated on the Office Action Summary form to be rejected. However, nowhere in pages 2 - 5 of the office action is there any further mention of this claim or the basis for its rejection. Accordingly, a *prima facie* showing for its rejection has not been made. The rejection therefore should be withdrawn.

II. DUNLOP AND JACKMAUH REFERENCES

35. The Examiner rejected claims **1, 3 - 10, 13, 20 - 22, 24 - 31, 33 - 42, 44,** and **46 - 54** under 35 U.S.C. 103 as being unpatentable over Dunlop (U.S. Patent No. 663,962) in view of Jackmauh (U.S. Patent No. 5,546,665). Applicant respectfully submits that none of the rejected claims is unpatentable over these cited references.

A. Dunlop Should Not Be Combined With Jackmauh

36. As an initial matter, Applicant submits that this rejection is not sustainable on the grounds that a *prima facie* case of obviousness has not been made. To establish a *prima facie* case of obviousness, among other things there must be some suggestion or motivation to combine reference teachings. MPEP §2143. Either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. MPEP 706.02(j).

37. In this matter, the Examiner stated that Dunlop fails to show the frame having inner and outer walls, but that Jackmauh shows an axle adjuster mounted between inner and outer walls of a frame. Then the Examiner concluded that it would have been obvious to provide the axle adjuster structure between inner and outer walls of the frame as taught by Jackmauh, in order to protect the movable parts of the apparatus.

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38. Applicant submits that this does not constitute an adequate showing of a motivation to combine Dunlop with Jackmauh. According to the MPEP, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01.III. Here the Examiner has not cited to any portion of Dunlop or Jackmauh where there is a suggestion as to the desirability of combining these references or of the desirability of protecting the movable parts of the apparatus. The Examiner stated at page 3 that "Jackmauh shows an axle adjuster mounted between inner and outer walls of a frame member 30 to conceal the adjuster in the frame." (emphasis added). Applicant submits that this is not a correct interpretation of Jackmauh. While the inability to see the adjuster may be inherent in Jackmauh, the Examiner cited no portion of this reference showing such concealment to be desirable or a goal.

39. Neither Dunlop nor Jackmauh points to the desirability of protection of motorcycle axle positioners as a relevant problem in need of a solution, nor does this constitute a convincing line of reasoning as to why an artisan would have combined these references. Dunlop should not be combined with Jackmauh because "protection of movable parts" of a motorcycle rear axle adjustor is not a valid motivation for this combination.

40. Because it is improper to combine references where there has not been an adequate showing of a motivation to combine them, Dunlop and Jackmauh do not render the rejected claims unpatentable, and withdrawal of the rejection to claims 1, 3 - 10, 13, 20 - 22, 24 - 31, 33 - 42, 44, and 46 - 54 is requested.

B. Independent Claims 1, 20 and 29 and the Actuator/Frame Bore Limitations

41. In addition to the reasons given in paragraphs 36 - 40 above, there are further grounds for withdrawing the rejections to claims 1, 20 and 29. In the office action, the Examiner has taken the position that Dunlop discloses all limitations of independent claims 1, 20 and 29 except for a frame having inner and outer walls. Applicant respectfully disagrees. These claims require that the inner and outer wall portions each have openings and that each opening extends into a frame cavity. Moreover, there must be an actuator adapted for insertion into a frame bore that extends from the frame cavity. The Examiner

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has cited no portion of Dunlop that discloses an actuator adapted for insertion into a frame bore that extends from a frame cavity.

42. The screw C2 of the drag link C of Dunlop extends rearwardly and engages a nut H. (FIG. 1) However this screw C2 does not extend from any frame cavity. In the office action, the Examiner has not made clear whether or what the Examiner considers to be a frame cavity in Dunlop. While the Examiner states at page 3 that the actuator "is mounted in a recess in frame A," it has not been made clear whether the Examiner considers a "recess" to be a frame cavity within the meaning of the rejected patent claims. Moreover, the office action does not specifically identify any portion of Dunlop that can be considered a "recess." According to the MPEP, it is important for the basis for a rejection be properly communicated so that the issues can be identified early and the applicant can be given fair opportunity to reply. MPEP 706.02(j). In this respect, therefore, a *prima facie* case of obviousness has not been made.

43. Because the Examiner has cited no portion of Dunlop that discloses this limitation, the rejections to claims 1, 20 and 29 should be withdrawn. Moreover, claims **3 - 10, 13, 21 - 22, 24 - 28, 30 - 31**, and **33 - 37** are dependent claims that depend directly or indirectly from one of the independent claims 1, 20 or 29, and contain additional limitations. The rejections to each of these dependent claims therefore should be withdrawn for the same reasons.

C. Method Claims 38 - 42, 44, and 46 - 50 are not Rendered Obvious by Dunlop in View of Jackmauh

44. In addition to the reasons given in paragraphs 36 to 40 above, there are further grounds for withdrawing the rejection to method claims **38 - 42, 44**, and **46 - 50**. Independent method claim 38 includes the limitation of inserting an axle coupler into a frame cavity. The Examiner has cited no portion of either Dunlop or Jackmauh that discloses this limitation.

45. As seen in FIG. 2 of Dunlop, the bolt E and the collar portion C5 of drag link C are disposed on the outside of the fork end B. The cited portions of Dunlop disclose no step of inserting an axle coupler into a frame cavity.

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46. Referring to FIG. 6 of Jackmauh, there is shown an axle nut 34 that engages an axle 32. The axle nut 34 and perhaps a washer abut the outer surface of a swing arm 30. The cited portions of Jackmauh however do not disclose the insertion of any axle coupler into a frame cavity.

47. Because the cited portions of neither Dunlop nor Jackmauh disclose this limitation, the rejection to independent method claim 38 should be withdrawn. Moreover, claims 39 - 42, 44, and 46 - 50 are dependent claims that depend directly or indirectly from claim 38, and contain additional limitations. The rejections to each of these dependent method claims therefore should be withdrawn for the same reasons.

D. Claims 51 - 54 are not Rendered Obvious by Dunlop in view of Jackmauh

48. In addition to the reasons given in paragraphs 36 to 40 above, there are further grounds for withdrawing the rejection to claims 51 - 54. Independent claim 51 requires that there be a coupling means that is adapted for insertion through a vehicle frame distal opening. The Examiner has cited no portion of either Dunlop or Jackmauh that discloses this limitation.

49. As to Dunlop, the Examiner stated that this reference "lacks inner and outer walls of the frame." (Page 3, Office Action) Thus the Examiner has cited no portion of Dunlop that discloses a distal opening for inserting an axle coupling means.

50. Referring to FIG. 6 of Jackmauh, there is shown an axle nut 34 that engages an axle 32. The axle nut 34 and perhaps a washer abut the outer surface of a swing arm 30. The cited portions of Jackmauh however do not disclose the insertion of any axle coupling means through a frame distal opening.

51. Because the cited portions of neither Dunlop nor Jackmauh disclose this limitation, the rejection to independent claim 51 should be withdrawn. Moreover, claims 52 - 54 are dependent claims that depend directly or indirectly from claim 51, and contain additional limitations. The rejections to each of these dependent claims therefore should be withdrawn for the same reasons.

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E. Additional Reasons Certain Dependent Claims are not Rendered Obvious by Dunlop in view of Jackmauh

52. Paragraphs 36 to 51 above have set forth several independent reasons why all of the claims that were rejected on the basis of Dunlop in view of Jackmauh should not have been rejected. As to certain dependent claims, however, there are yet further independent reasons why the rejections to those claims should be withdrawn.

53. (Claims **4, 21, 30** and **44**): Claims **4, 21** and **30** each require that the axle coupler be adapted for insertion into the frame cavity through the frame distal opening. Similarly, claim **44** requires inserting the axle coupler into the frame cavity through the frame distal opening. For the reasons given in paragraphs 48 to 51 above, the cited portions of neither Dunlop nor Jackmauh disclose this limitation. Accordingly the rejection to claims 4, 21, 30 and 44 should be withdrawn.

54. Claims **5, 22, 31** and **46** have been amended so that each requires the axle coupler to have a generally cylindrically-shaped body portion and a threaded extension portion extending from the body portion. These claims further require that the adjustor member bearing surface define an opening adapted to mate with the generally cylindrically-shaped body portion of axle coupler. Applicant contends that none of the cited portions of Dunlop or Jackmauh disclose this opening limitation.

55. The drag link C of Dunlop has an opening. However, this opening is for the threaded extension portion of the bolt E to pass through. Similarly, the stud 16 of Jackmauh includes a ring 12. However this ring 12 is for the axle 32 to pass through. The Examiner has cited no portion of either Dunlop or Jackmauh that disclose an adjuster member opening adapted to mate with a generally cylindrically-shaped body portion of an axle coupler. The rejection to claims 5, 22, 31 and 46 therefore should be withdrawn.

56. Claims **6, 24, 33, 42** and **52** require the frame bore to extend longitudinally from the frame cavity through the frame in a direction generally away from the first axle and the second axle. In paragraphs 41 to 43 above, Applicant has shown the deficiencies in the rejections to dependent claims 6, 24 and 33 with respect to a frame bore that extends from a frame cavity. Applicant repeats those arguments in paragraphs 41 - 43 as grounds for withdrawing the rejection to claims 42 and 52 as well.

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57. Additionally, however, claims 6, 24, 33, 42 and 52 each further require that the bore extend from the cavity through the frame in a direction generally away from the first and the second axle. In the office action, the Examiner has taken the position that Dunlop discloses all limitations of claims 6, 24, 33, 42 and 52 except for a frame having inner and outer walls. Applicant respectfully disagrees. Applicant contends that the Examiner has cited no portion of Dunlop that discloses this additional limitation pertaining to the direction that the bore extends.

58. The Examiner has cited no portion of Dunlop that discloses any bore extending from a cavity through a frame. The rejections to claims 6, 24, 33, 42 and 52 therefore should be withdrawn.

59. Claims **8, 26, 35, 47** and **53** require the axle coupler (or the coupling means, as the case may be) to have a proximate end adapted to engage the first axle (or to couple the first axle to the adjustor member, as the case may be) and a distal end, wherein the distal end is disposed within the frame cavity. As explained in paragraphs 41 to 43, a *prima facie* case has not been made with respect to the frame cavity limitation. Applicant repeats those arguments here, and further notes that the bolt E of Dunlop abuts a collar portion C5 of the drag link C which in turn abuts the outer surface of the fork end B. The Examiner has cited no specific portion of Dunlop that discloses a frame cavity nor that discloses a distal end of an axle coupler that is disposed within the frame cavity.

60. Similarly, there has been no cited portion of Jackmauh that discloses an axle coupler distal end disposed within a frame cavity. Jackmauh shows an axle nut 34 that is mounted entirely outside of the swing arm 30. There is no explanation, however, whether or how Jackmauh discloses this claim limitation. The rejections to claims 8, 26, 35, 47 and 53 therefore should be withdrawn.

61. Claims **9, 27, 36, 48** and **54** include the limitation that no portion of the axle coupler (or of the coupling means, as the case may be) extend outside of the frame cavity through the frame distal opening. As to Dunlop, the Examiner stated that this reference "lacks inner and outer walls of the frame." (Page 3, Office Action) Thus the Examiner has cited no portion of Dunlop that discloses a distal opening.

62. Referring again to FIG. 6 of Jackmauh, there is shown an axle nut 34 that engages an axle 32. The axle nut 34 and perhaps a washer abut the outer surface of a swing arm 30.

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The cited portions of Jackmauh however do not disclose this limitation. Therefore because the cited portions of neither Dunlop nor Jackmauh disclose this limitation, the rejection to claims 9, 27, 36, 48 and 54 should be withdrawn.

63. Method claim **39** includes the limitation of inserting the actuator into the vehicle frame bore. In paragraphs 41 to 43 above, Applicant has shown the deficiencies in the rejections to certain claims with respect to a frame bore. Paragraphs 41 - 43 are incorporated herein as grounds for withdrawal of the rejection to claim 39.

64. Additionally, however, claim 39 requires that the actuator be inserted into the bore. In the office action, the Examiner has taken the position that Dunlop discloses all limitations of claim 39 except for a frame having inner and outer walls. Applicant respectfully disagrees. Applicant contends that the Examiner has cited no portion of Dunlop that discloses this additional limitation pertaining to the insertion of the actuator into a frame bore. Accordingly, the rejection to claim 39 should be withdrawn.

65. Method claim **41** includes the step of inserting the adjustor member into the frame cavity through the proximate opening which is defined by the inner wall portion of the frame. As to Dunlop, the Examiner stated that this reference "lacks inner and outer walls of the frame." (Page 3, Office Action) Thus the Examiner has cited no portion of Dunlop that discloses a proximate opening.

66. Jackmauh shows an axle 32 passing through an opening in a swing arm 30. The cited portions of Jackmauh however do not disclose the insertion of an adjustor member into a frame cavity through a proximate opening which is defined by the inner wall portion of the frame. Therefore because the cited portions of neither Dunlop nor Jackmauh disclose this limitation, the rejection to claim 41 should be withdrawn.

67. With respect to claim **43**, this claim is indicated on the Office Action Summary form to be rejected. However, nowhere in pages 2 - 5 of the office action is there any further mention of this claim or the basis for its rejection. Accordingly, a *prima facie* showing for its rejection has not been made. The rejection therefore should be withdrawn.

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III. DUNLOP, JACKMAUH AND WATANABE REFERENCES

68. Dependent claims **2, 11, 23, 32** and **45** were rejected under 35 U.S.C. 103 as being unpatentable over Dunlop and Jackmauh as applied to the claims discussed above (*i.e.*, to claims 1, 3 - 10, 13, 20 - 22, 24 - 31, 33 - 42, 44, and 46 - 54), and further in view of Watanabe (U.S. Patent No. 4,634,139). Applicant respectfully submits that none of these rejected claims is unpatentable over these cited references.

69. In paragraphs 36 to 40 above, Applicant has shown that Dunlop should not be combined with Jackmauh. Applicant incorporates those arguments herein as independent grounds for withdrawing the rejection to claims 2, 11, 23, 32 and 45.

A. Watanabe Should Not Be Combined With Dunlop and Jackmauh

70. As yet further grounds for withdrawing the rejection to claims 2, 11, 23, 32 and 45, Applicant submits that it is improper to combine Watanabe with Dunlop and Jackmauh. This rejection is not sustainable because a *prima facie* case of obviousness has not been made. To establish a *prima facie* case of obviousness, among other things there must be some suggestion or motivation to modify the reference or to combine reference teachings. MPEP §2143. When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. MPEP §2142.

71. In this matter, the Examiner stated that the combination of Dunlop and Jackmauh fails to show a cover piece for covering the frame proximate opening and having a cover piece opening for passage of the axle, but that Watanabe shows a cover piece bolted to an inner side of frame 12 to provide axle support and protect the inner sides of the fork arms. Then the Examiner concluded that it would have been obvious to provide a cover piece as taught by Watanabe, in order to provide support for the axle and protect the inner side of rear fork arms.

72. Applicant contends that this does not constitute an adequate showing of the motivation to combine Watanabe with the combination of Dunlop and Jackmauh. According to the MPEP, the mere fact that references can be combined or modified does not render the

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resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01.III. Claims 2, 11, 23, 32 and 45 require that the frame cover piece be adapted to cover at least a portion of the frame proximate opening (defined by a frame inner wall portion) when the adjustor is in the frame cavity.

73. Here the Examiner has not cited to any portion of Watanabe or Dunlop or Jackmauh where there is a suggestion of the motivation or desirability of using a cover piece to cover a frame opening. Moreover the Examiner has not cited to any portion of those references where there is a suggestion of using a cover piece to cover a frame opening when an adjustor is in a frame cavity. Indeed, the Examiner has not cited to any portion of Watanabe that discloses a frame cavity at all. The guide plate 26 in Watanabe abuts one side of a fork arm 12. On the other hand, the adjusting plate 22 is disposed on the opposite side of the fork arm 12 and is not shown to be located in a frame cavity. (FIG. 4).

74. The guide plate 26 of Watanabe does not cover a portion of a frame proximate opening when an adjustor is in a frame cavity. The guide plate 26 of Watanabe therefore does not appear in the same configuration as the cover piece of Applicant's claims. Therefore, there is no motivation to combine Watanabe with the Dunlop and Jackmauh combination.

75. Because it is improper to combine references where there has not been an adequate showing of a motivation to combine them, Watanabe, Dunlop and Jackmauh do not render the rejected claims unpatentable. Withdrawal of the rejection to claims 2, 11, 23, 32 and 45 is requested.

B. Parent Claims to Dependent Claims 2, 11, 23, 32 and 45 are Lacking Certain Limitations

76. Independent grounds exit for withdrawing the rejection to claims 2, 11, 23, 32 and 45. In paragraphs 41 to 47, Applicant pointed out that the portions of Fuller and Jackmauh cited by the Examiner did not disclose certain limitations in the parent claims of dependent claims 2, 11, 23, 32 and 45. Because these dependent claims include the limitations of the parent claims (and further contain additional limitations), the rejections to each of these dependent claims 2, 11, 23, 32 and 45 should be withdrawn for the same reasons.

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CONCLUSION

For all the reasons advanced above, Applicant submits that the application is in a condition for allowance and that action is earnestly solicited.

Respectfully submitted,

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